



PATENT
Customer Number 22,852
Attorney Docket No. 07414.0101-18000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Paul D. GROSSMAN et al.) Group Art Unit: 1637
)
Application No.: 10/825,624) Examiner: Kenneth R. HORLICK
)
Filed: April 14, 2004) Confirmation No.: 7889
)
For: METHOD FOR DISTINGUISHING)
DIFFERENT-SEQUENCE)
POLYNUCLEOTIDES)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TERMINAL DISCLAIMER

Petitioner Applera Corporation, duly organized under the laws of the State of Delaware, and having its principal place of business at 850 Lincoln Centre Drive, Foster City, California, 94404, represents that it is an assignee of the entire right, title and interest in and to the above-identified application, U.S. Patent Application No. 10/825,624, filed April 14, 2004, for Method for Distinguishing Different-Sequence Polynucleotides, as indicated by an assignment from PE Corporation (NY) duly recorded in the U.S. Patent and Trademark Office for parent U.S. Patent Application No. 10/170,044, now U.S. Patent No. 6,756,204, at Reel 013367, Frame 0173. PE Corporation (NY) was the sole assignee of prior parent U.S. Application No. 07/866,018 ("the '018 application"), now U.S. Patent No. 5,470,705, by a Change of Name Document executed by The Perkin-Elmer Corporation and recorded in the U.S. Patent and Trademark Office at Reel 012676, Frame 0767. The Perkin-Elmer Corporation was

the sole assignee of the '018 application by Merger of The Perkin-Elmer Corporation with Applied Biosystems, Inc., duly recorded in the U.S. Patent and Trademark Office at Reel 007408, Frame 0429. Applied Biosystems, Inc. was the sole assignee of the '018 application, by an assignment executed by inventors Paul D. Grossman, Steven Fung, Steven M. Menchen, Sam L. Woo, and Emily S. Winn-Deen, and duly recorded in the U.S. Patent and Trademark Office at Reel 006212, Frame 0168.

Applera Corporation further represents that it is an assignee of the entire right, title and interest in and to U.S. Patent Nos. 5,807,682 and 5,624,800, which issued from U.S. Application Nos. 08/877,460 and 08/447,174, respectively, as indicated by an assignment from PE Corporation (NY) duly recorded in the U.S. Patent and Trademark Office at Reel 013563, Frame 0534. PE Corporation (NY) was the sole assignee of U.S. Patent Nos. 5,807,682 and 5,624,800, by a Change of Name Document executed by The Perkin-Elmer Corporation and recorded in the U.S. Patent and Trademark Office at Reel 012676, Frame 0767. The Perkin-Elmer Corporation was the sole assignee of prior parent U.S. Application No. 07/866,018 ("the '018 application"), now U.S. Patent No. 5,470,705, by Merger of The Perkin-Elmer Corporation with Applied Biosystems, Inc., duly recorded in the U.S. Patent and Trademark Office at Reel 007408, Frame 0429. Applied Biosystems, Inc. was the sole assignee of the '018 application, by an assignment executed by inventors Paul D. Grossman, Steven Fung, Steven M. Menchen, Sam L. Woo, and Emily S. Winn-Deen, and duly recorded in the U.S. Patent and Trademark Office at Reel 006212, Frame 0168.

Applera Corporation further represents that it is an assignee of the entire right, title and interest in and to U.S. Patent No. 5,580,732, issued from U.S. Application No. 08/296,880, as indicated by an assignment from PE Corporation (NY) duly recorded in

the U.S. Patent and Trademark Office at Reel 013563, Frame 0534. PE Corporation (NY) was the sole assignee of U.S. Patent No. 5,580,732, by a Change of Name Document executed by The Perkin-Elmer Corporation and recorded in the U.S. Patent and Trademark Office at Reel 012676, Frame 0767. The Perkin-Elmer Corporation was the sole assignee of U.S. Application No. 08/296,880 by an assignment executed by inventors Paul D. Grossman, Steven Fung, Steven M. Menchen, Sam L. Woo, and Emily S. Winn-Deen, and duly recorded in the U.S. Patent and Trademark Office at Reel 007739, Frame 0951.

Applera Corporation further represents that it is an assignee of the entire right, title and interest in and to U.S. Patent No. 5,470,705, which issued from U.S. Application No. 07/866,018 ("the '018 application"), as indicated by an assignment from PE Corporation (NY) duly recorded in the U.S. Patent and Trademark Office at Reel 013563, Frame 0534. PE Corporation (NY) was the sole assignee of the '018 application by a Change of Name Document executed by The Perkin-Elmer Corporation and recorded in the U.S. Patent and Trademark Office at Reel 012676, Frame 0767. The Perkin-Elmer Corporation was the sole assignee of the '018 application, by Merger of The Perkin-Elmer Corporation with Applied Biosystems, Inc., duly recorded in the U.S. Patent and Trademark Office at Reel 007408, Frame 0429. Applied Biosystems, Inc. was the sole assignee of the '018 application, by an assignment executed by inventors Paul D. Grossman, Steven Fung, Steven M. Menchen, Sam L. Woo, and Emily S. Winn-Deen, and duly recorded in the U.S. Patent and Trademark Office at Reel 006212, Frame 0168.

Assignee Applera Corporation further represents that to the best of its knowledge and belief, title to U.S. Patent Application No. 10/825,624 and U.S. Patent Nos. 6,756,204; 5,807,682; 5,624,800; 5,580,732; and 5,470,705 is in Applera Corporation.

To obviate a double patenting rejection, Applera Corporation hereby disclaims, under the provisions of 37 C.F.R. § 1.321, the terminal part of any patent granted on U.S. Patent Application No. 10/825,624, which would extend beyond the expiration date of U.S. Patent No. 6,756,204, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 6,756,204, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, the assignee does not disclaim the terminal part of any patent granted on U.S. Patent Application No. 10/825,624 that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of U.S. Patent No. 6,756,204, as presently shortened by any terminal disclaimer, in the event that U.S. Patent No. 6,756,204 expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term, as presently shortened by any terminal disclaimer.

To obviate a double patenting rejection, Applera Corporation hereby disclaims, under the provisions of 37 C.F.R. § 1.321, the terminal part of any patent granted on U.S. Patent Application No. 10/825,624, which would extend beyond the expiration date

of U.S. Patent No. 5,807,682, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 5,807,682, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, the assignee does not disclaim the terminal part of any patent granted on U.S. Patent Application No. 10/825,624 that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of U.S. Patent No. 5,807,682, as presently shortened by any terminal disclaimer, in the event that U.S. Patent No. 5,807,682 expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term, as presently shortened by any terminal disclaimer.

To obviate a double patenting rejection, Applera Corporation hereby disclaims, under the provisions of 37 C.F.R. § 1.321, the terminal part of any patent granted on U.S. Patent Application No. 10/825,624, which would extend beyond the expiration date of U.S. Patent No. 5,624,800, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 5,624,800, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, the assignee does not disclaim the terminal part of any patent granted on U.S. Patent Application No. 10/825,624 that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of U.S. Patent No. 5,624,800, as presently shortened by any terminal disclaimer, in the event that U.S. Patent No. 5,624,800 expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term, as presently shortened by any terminal disclaimer.

To obviate a double patenting rejection, Applera Corporation hereby disclaims, under the provisions of 37 C.F.R. § 1.321, the terminal part of any patent granted on U.S. Patent Application No. 10/825,624, which would extend beyond the expiration date of U.S. Patent No. 5,580,732, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 5,580,732, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, the assignee does not disclaim the terminal part of any patent granted on U.S. Patent Application No. 10/825,624 that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of U.S. Patent No. 5,580,732, as presently shortened by any terminal disclaimer, in the event that U.S. Patent No. 5,580,732 expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily

disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term, as presently shortened by any terminal disclaimer.

To obviate a double patenting rejection, Applera Corporation hereby disclaims, under the provisions of 37 C.F.R. § 1.321, the terminal part of any patent granted on U.S. Patent Application No. 10/825,624, which would extend beyond the expiration date of U.S. Patent No. 5,470,705, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 5,470,705, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, the assignee does not disclaim the terminal part of any patent granted on U.S. Patent Application No. 10/825,624 that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of U.S. Patent No. 5,470,705, as presently shortened by any terminal disclaimer, in the event that U.S. Patent No. 5,470,705 expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term, as presently shortened by any terminal disclaimer.

In accordance with the fee schedule set forth in 37 C.F.R. § 1.20(d), the required fee of \$130.00 is being filed with this disclaimer.

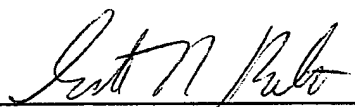
If there are any additional fees due in connection with the filing of this Terminal Disclaimer, please charge the fees to Deposit Account No. 06-0916. If any further fee and/or petition is required for an extension of time under 37 C.F.R. § 1.136 and is not accounted for above, such an extension is requested and the fee should also be charged to Deposit Account No. 06-0916.

The undersigned is authorized to act on behalf of assignee Applera Corporation.

I hereby declare that all statements made of my own knowledge and belief are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

4/18/06
Date

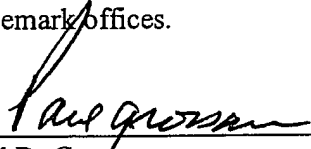

Scott R. Bortner, Reg. No. 34,298
Director, Molecular Biology Patent Practice
Applera Corporation

**LIMITED AUTHORIZATION TO ACT ON BEHALF OF ASSIGNEE
REGARDING CERTAIN PATENT AND TRADEMARK MATTERS
EFFECTIVE THROUGH: December 31, 2008**

I, Paul D. Grossman, as Assistant Secretary of Applera Corporation ("Applera"), hereby authorize the following patent attorneys:

Scott R. Bortner, Reg. No. 34,298
John W. Burns, Reg. No. 43,520
Jeffery D. Frazier, Reg. No. 34,601
Brian D. Gildea, Reg. No. 39,995
Andrew T. Karnakis, Reg. No. 27,909
Phil N. Makrogiannis, Reg. No. 47,766
Vincent M. Powers, Reg. No. 36,246

(1) to act on behalf of Applera, with regard to any matters before the United States Patent and Trademark Office, any foreign patent or trademark offices, and any international patent or trademark entities, (2) to execute power of attorney documents on behalf of Applera, to appoint and/or establish any attorneys, agents, and/or law firms to act on behalf of Applera, in any foreign or international patent or trademark applications filed with any foreign and/or international patent or trademark offices, and (3) to execute assignment and ownership documents on behalf of Applera, with regard to any matters before the United States Patent and Trademark Office, any foreign patent or trademark offices, and any international patent or trademark offices.

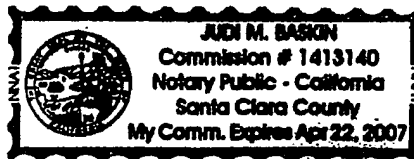


Paul D. Grossman
Assistant Secretary,
Applera Corporation

2/15/06

Date

State of California)
) ss.
County of San Mateo)



On 2/15, 2006 before me, Judi Baskin Notary Public, personally appeared Paul D. Grossman, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument and acknowledged to me that he executed the same in his authorized capacity(ies), and that by his signature on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.



Notary Public